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10/587,432	07/27/2006	Masahiro Oho	2006_1156A	8885
52349 7590 03/18/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
QAYYUM, ZESHAN				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
03/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/587,432

Applicant(s)

OHO ET AL

Examiner

ZESHAN QAYYUM

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 4-7 and 9-25 have been examined.

Response to Arguments

2. Applicant's arguments filed 11/16/2009 have been fully considered but they are not persuasive.
3. Applicant is of the opinion that prior art fail to teach " A service provider unit (or step) that inserts the content key into the license information when the usage condition is within the range indicated by the edit condition information, and does not insert the content key into the license information when the usage condition is not within the range indicated by the edit condition information; the terminal device of the end user decrypts the content using the content key included in the license information when the usage condition included in the license information is within the range indicated by the edit condition information, and abandons the license information when the usage condition is not within the range indicated by the edit condition information". The Examiner respectfully disagrees. Ginter discloses: A service provider unit that inserts the content key into the license information when the usage condition is within the range indicated by the edit condition information, and does not insert the content key into the license information when the usage condition is not within the range indicated by the edit condition information; the terminal device of the end user decrypts the content using the content key included in the license information when the usage

condition included in the license information is within the range indicated by the edit condition information, and abandons the license information when the usage condition is not within the range indicated by the edit condition information (See column 19, lines 9-58, column 30, lines 29-40, Fig 17, 79, Column 155 lines 38-67, column 156 lines 1-10 and column 281 lines 23-26).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1, 4-7 and 9-25 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Claim 1 recites "a content provider unit", "a service provider unit", "a content providing unit", "a content key providing unit", "an edit condition information providing unit" and "a content obtainment unit" these limitations were not described in the specification.
6. Claims 4-6 are also rejected as each depends from claim 1.
7. Claim 7 recites "a content provider unit" this limitation was not described in the specification.

8. Claim 9-18 are also rejected as each depends from claim 7.
9. Claim 19 recites "a service provider unit" this limitation was not described in the specification.
10. Claim 20 recites "a service provider unit, a content provider unit, a license information generation unit and a content key obtainment unit. These limitations were not described in the specification.
11. Claim 21 recites "a request unit, a license information obtainment unit and service provider unit" these limitations were not described in the specification.
12. Claims 22 and 24-25 recite "a content provider unit" this limitation was not described in the specification.
13. Claim 23 recites "a service provider unit" this limitation was not described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1, 4-6 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
15. Claim 1 recites "a usage condition" in line 21. It is unclear to one of the ordinary skill in the art is this usage condition the same as recited in line 12? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

16. Claim 1 recites "a content key obtainment unit configured to obtain, from said second right management device included in said content provider unit" in line 24. It is unclear to one of the ordinary skill in the art because the second right management device included in the content provider unit or the service provider unit? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)). For the examination purpose Examiner interprets as "a content key obtainment unit configured to obtain, from said first right management device included in said content provider unit".
17. Claim 20 recites the limitations "the second range designation obtainment unit" and "the second usage condition judgment unit in line 10 and 13 respectively. There is insufficient antecedent basis for this limitation in the claim.
18. Claims 4-6 are also rejected as each depends from claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 4-7 and 9-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs (US 6226618) in view of Ginter (US 5892900).
20. With respect to claims 1, 7, 9, 10-12 and 19-25 Down discloses: a content provider unit that produces the content, said content provider unit including a first

right management device (See column 9, lines 5-60); a service provider unit that issues the license information to an end user, said service provider unit including a second right management device (See column 10, lines 50-67); a terminal device for the end user to use the content (See column 11, lines 30-54), wherein said first management device comprises: a content providing unit configured to encrypt the produced content using a content key, and provide the encrypted content to said terminal device; an edit condition information generation unit configured to generate edit condition information indicating designation of a range of a usage condition which said second right management device is allowed to set in the license information, the usage condition allowing the end user to use the content: a content key providing unit configured to provide a content key used for encrypting the content to said second right management device: and an edit condition information providing unit configured to cause said second right management device to obtain the generated edit condition information (See column 9, lines 5-60); wherein said second right management device comprises a license information generation unit configured to generate the license information to include a usage condition for allowing usage of the content; a transmission unit operable configured to transmit the generated license information to said terminal device (See column 10, lines 50-67); a content key obtainment trait configured to obtain, from said first right management device included in said content provider unit. the content key used for encrypting the content ; a second range designation obtainment unit; a

second usage condition judgment unit; and a second validation unit; wherein said second range designation obtainment unit is configured to obtain edit condition information generated by said first right management device that indicates a range designation of the usage condition, said second usage condition judgment unit is configured to judge whether or not the usage condition is within the range designated in the edit condition information, and said second validation unit is configured to insert the content key, which is a key for decrypting the encrypted content, into the generated license information only when the usage condition is within the range (See column 10, lines 50-67, column 18, lines 11-67 and column 19, lines 1-35) wherein said terminal device comprises: a reception unit configured to receive the license information from said second right management device (See column 10, lines 50-67).

Down does not explicitly disclose: a range designation obtainment unit configured to obtain the edit condition information generated by said first right management device that indicates the range designation of the usage condition included in the license information; a usage condition judgment unit configured to judge whether or not the usage condition included in the license information received from said second right management device is within the range designated in the obtained edit condition information; and a validation unit configured to validate the received license information and decrypt the content using the content key included in the license information only when the usage condition is judged to be within the range, and abandon the received license

information when the usage condition is judged not to be within the range. Ginter discloses: a range designation obtainment unit configured to obtain the edit condition information generated by said first right management device that indicates the range designation of the usage condition included in the license information; a usage condition judgment unit configured to judge whether or not the usage condition included in the license information received from said second right management device is within the range designated in the obtained edit condition information; and a validation unit configured to validate the received license information and decrypt the content using the content key included in the license information only when the usage condition is judged to be within the range, and abandon the received license information when the usage condition is judged not to be within the range (See column 19, lines 9-58, column 30, lines 29-40, Fig 79, and column 281 lines 23-26) Therefore, it would have been obvious to one of the ordinary skill in the art at the time invention was made to modify Down with Ginter reference in order to provide extra security for content distribution.

In addition with respect to claim 1 "a content providing unit configured to encrypt the produced content using a content key; and provide the encrypted content to said terminal device; an edit condition information generation unit configured to generate edit condition information indicating designation of a range of a usage condition which said second right management device is allowed to set in the license information, the usage condition allowing tile end user to use the content:

a content key providing unit configured to provide a content key used for encrypting the content to said second right management device; and an edit condition information providing unit configured to cause said second right management device to obtain tile generated edit condition information" these are nonfunctional descriptive material because it just describing the data store in the device. *The broadest interpretation of units in above limitations is software.*

Therefore, it has been held that nonfunctional descriptive material will not distinguish the invention from prior art in term of patentability (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994).

In addition with respect to claim 7 "a license information generation unit configured to generate the license information to include a usage condition that indicates a condition for allowing usage of the content; a content provider unit that produces the content, said content provider unit including a content provider right management device; a range designation reception unit configured to receive edit condition information generated by the content provider right management device in said right management device which indicates range designation of the usage condition; a content key obtainment unit configured to obtain a content key, used for encrypting the content, from said content provider right management device; a usage condition judgment unit configured to judge whether or not the usage condition included in the generated license information is within the range designated in the edit condition information; and a validation

unit configured to validate the generated license information and insert the content key, into the license information when the usage condition is judged to be within the range, and not to insert the content key into the license information when the usage condition is judged not to be within the range, wherein said license information generation unit is configured to insert the edit condition information, which is obtained by said range designation reception unit, into the license information" these are nonfunctional descriptive material because it just describing the data store in the device. Therefore, it has been held that nonfunctional descriptive material will not distinguish the invention from prior art in term of patentability (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994).

In addition with respect to claim 19, "*a request unit configured to request the license information used for reproducing a specific content from a right management device of a service provider unit; a license information obtainment unit configured to obtain, in response to the request, the license information including a usage condition that indicates a condition for allowing the usage of the content, and edit condition information designating a range of the usage condition; a usage condition judgment unit configured to judge whether or not the usage condition is within the range designated in the edit condition information; a validation unit configured to validate the received license information and decrypt the content using a content key included in the license information when the usage condition is judged to be within the range; and an abandon unit*

configured to abandon the obtained license information when the usage condition is judged not to be within the range designated in the edit condition" these are nonfunctional descriptive material because it just describing the data store in the device. Therefore, it has been held that nonfunctional descriptive material will not distinguish the invention from prior art in term of patentability (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994).

21. With respect to claims 4, 5, and 6, 13, 14, 15, 16, 17, 18, Downs in view of Ginter discloses all the limitations as described above. Ginter further discloses: said first right management device comprises a contract license (i.e. PERC) generation unit operable to generate contract license information including the content key and the edit condition information and, a transmission unit operable to transmit the generated contract license to said second right management device; and said second right management device further comprises a contract license reception unit operable to receive the contract license from said first right management device; said second range designation obtainment unit is operable to obtain the edit condition information from the received contract license; said second usage condition judgment unit is operable to judge whether or not the usage condition included in the generated license information is within the range shown in the obtained edit condition information; and said second validation unit is operable to extract the content key from the received contract license and to insert the

extracted content key into the generated license information only when the usage condition is within the range. See column 19, lines 9-58, column 30, lines 29-40, Fig 79, column 155, lines 38-67, column 156 lines 1-10, and column 281, lines 23-26).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685